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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,556	09/29/2006	Samuel J. Danishefsky	2003080-0210 (SK-1156-US)	9739
24280 7590 03/31/2008 CHOATE, HALL & STEWART LLP TWO INTERNATIONAL PLACE BOSTON, MA 02110				
EXAMINER				
HA, JULIE				
ART UNIT		PAPER NUMBER		
1654				
NOTIFICATION DATE		DELIVERY MODE		
03/31/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@choate.com

Office Action Summary

Application No.

10/570,556

Applicant(s)

DANISHEFSKY ET AL.

Examiner

JULIE HA

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/86)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Sequence Non-compliance form

DETAILED ACTION

Sequence Non-compliance

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth below. **All sequences disclosed in the application must comply with the requirements of 37 C.F.R. 1.821-1.825, not only those recited in the claims.**

The sequences are recited in Claims 35-40 and throughout the specification (for example, FIG 1 and 2).

All such sequences are relevant for the purposes of building a comprehensive database and properly assessing prior art. It is therefore essential that all sequences, whether only disclosed or also claimed, be included in the database.

Applicant is given **ONE MONTH**, or **THIRTY DAYS**, whichever is longer, from the mailing date of this letter within which to comply with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in **ABANDONMENT** of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). In no case may an applicant extend the period for reply beyond the **SIX MONTH** statutory period. Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply. **Please note that examination cannot continue unless the sequence compliance rule requirements are fulfilled.** The

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applicant should carefully review the specification for any other sequences, in order to avoid necessitating a second Notice To Comply and hindering prosecution. The notice to comply is attached separately with this office action.

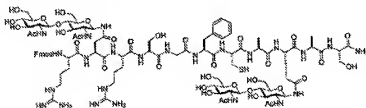
Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

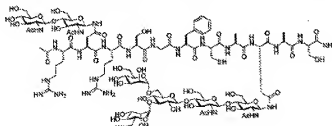
In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 35, drawn to a method of preparing a polyfunctionalized peptide of



structure

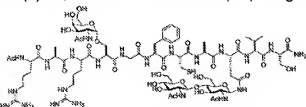
Group 2, claim(s) 36, drawn to a method of preparing a polyfunctionalized peptide of



structure

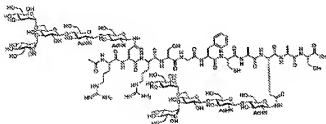
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Group 3, claim(s) 37, drawn to a method of preparing a polyfunctionalized peptide of



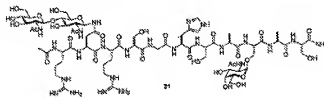
structure

Group 4, claim(s) 38, drawn to a method of preparing a polyfunctionalized peptide of



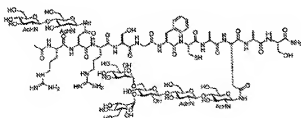
structure

Group 5, claim(s) 39, drawn to a method of preparing a polyfunctionalized peptide of



structure

Group 6, claim(s) 40, drawn to a method of preparing a polyfunctionalized peptide of



structure

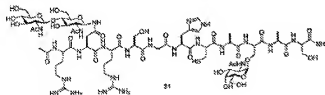
2. Claims 1-34 link(s) inventions 1-6. The restriction requirement among the linked inventions is **subject to** the nonallowance of the linking claim(s), claims 1-34. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise

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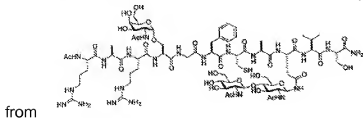
requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. The inventions listed as Groups 1-6 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The inventions lack unity because there is no common core structure in the invention. The structures have different moieties and different peptide sequences, therefore the structures are patentably independent and distinct. For example,



is patentably independent and distinct



from

. Therefore, there is lack of unity.

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Furthermore, the situation involving the so-called Markush practice wherein a single claim defines alternatives (chemical or non-chemical) is also governed by PCT Rule 13.2. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in PCT Rule 13.2, shall be considered to be met when the alternatives are of a similar nature.

When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

(A) All alternatives have a common property or activity; and

(B)

(1) A common structure is present, i.e., a significant structural element is shared by all of the alternatives; or

(B)

(2) In cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

In paragraph (B)(1), above, the words "significant structural element is shared by all of the alternatives" refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art, and the common structure is essential to the common property or activity. The structural element may be a single component or a combination of individual components linked together.

4. In paragraph (B)(2), above, the words "recognized class of chemical compounds" mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

5. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

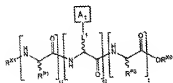
Election of Species

6. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

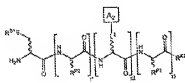
Different peptidic backbone due to different variables within the moiety 

Different peptide acyl donor having the structure



, etc due to different variables:

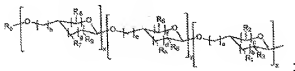
Different peptide amine acceptor having the structure



, etc due to different variables:

Different A, A1, and A2: biomolecule, a small molecule, a macromolecule, or diagnostic label species;

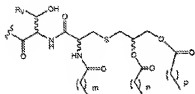
Different subspecies of carbohydrate due to different variables:



Different subspecies of protein: bovine serum albumin (BSA), keyhole limpet


hermocyanin (KLH) or polylysine;

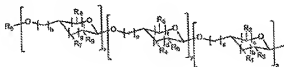
Different subspecies of lipid carrier due to different variables:



7. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

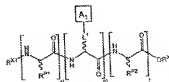
8. For any Group elected, Applicant is required to elect a single disclosed species

of , a peptide acyl donor, a peptide amino acceptor etc where all of the variables are elected to arrive at a single disclosed structure of the species. For



example, A is

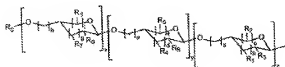
wherein R0 is H, R1-R9 are



OH, x is 2, y is 1 and z is 0; a peptide acyl donor is

wherein

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A1 is wherein R0 is H, R1-R9 are OH, x is 2, y is 1 and z is 0, RX1 is H, RP1 is H, L1 is $-\text{O}-(\text{CH}_2)_n-\text{CH}_2$ and n is 3, RP2 is H, etc to arrive at a single disclosed species of peptide acyl donor, peptide amine acceptor and so on. If immunogenic carrier is conjugated to the polyfunctionalized peptide, Applicant is required to elect a single disclosed species of immunogenic carrier (wherein all of the variables are also elected to arrive at a single disclosed species). For example, Applicant elects peptide (species) and polylysine as subspecies.

9. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

10. The claims are deemed to correspond to the species listed above in the following manner:

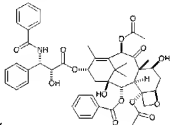
Claims 1, 4-27, 30, 31 and 34

The following claim(s) are generic: 2-3, 28-29 and 33.

11. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The different peptidic backbone are patentably independent and distinct due to different variables and amino acid content, leading to different structures. For example, a peptide having the sequence RTYGA is patentably independent and distinct from a peptide sequence having the sequence GRHAR. Further, search for one would not necessarily lead to the other. Different peptide acyl donor is patentably independent and distinct from each other due to the different variables, leading to distinct structures. Further, search for one would not necessarily lead to the other. Different peptide amino acceptor is patentably

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independent and distinct from each other due to the different variables, leading to distinct structures. Further, search for one would not necessarily lead to the other. Biomolecule, a small molecule, a macromolecule, or diagnostic label species is patentably independent and distinct from each other because of different structures. For example, a biomolecule, such as insulin (A and B chains) is structurally independent



and distinct from a small molecule, taxol (). Further, search for one would not necessarily lead to the other. Different immunogenic carrier is patentably independent and distinct one from the other due to their different structures. For example, BSA is a 609 residue protein while polylysine is a peptide sequence having multi lysine residues. Further, search for one would not necessarily lead to the other. Different lipid carriers are patentably independent and distinct due to different variables. Further, search for one would not necessarily lead to the other.

12. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

13. The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

14. **Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species**

unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

15. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JULIE HA whose telephone number is (571)272-5982. The examiner can normally be reached on Mon-Thurs, 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Julie Ha/
Examiner, Art Unit 1654

/Anish Gupta/
Primary Examiner, Art Unit 1654